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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,137	12/23/2005	Matthias Vennemann	27098U	5622
34375 7590 12/16/2009 NATH & ASSOCIATES PLLC 112 South West Street Alexandria, VA 22314				
EXAMINER DESAL, RITA J				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
12/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,137

Applicant(s)

VENNEMANN ET AL.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1-14, 17-20 are pending.

Claim 9 is included in the elected group as R7 is drawn to a phenyl .

Response to the arguments:-

The rejection under 35 USC 112 has been partly withdrawn as applicants have amended the claims to a certain extent which does not include R5 and R4 to be a bond.

The first proviso has R1 to be a hydroxyl nor a trifluoro methoxy, whereas R1, R2 or R3 do not have that definition at all , neither is the definition that they can together form a dioxy group. For the second proviso the claim should have R82 and R83 and R5 as amended can never be a hydrogen.

Claim 3 has provisos which re outside the scope of the elected group R5 and R51 are not both H.

The claims still have several provisos and it is not clear what is actually claimed.

See *In re ROSE*, 86 USPQ 77 (C.C.P.A. 1950) where both the board and the appellate court affirmed the examiner, who stated:

“negative expression is believed to be bad because it attempts to recite what applicant does not show rather than the apparatus disclosed. This expression was used in an attempt to distinguish over a reference which uses springs for the same purpose as applicant uses the hydraulic jacks. It is believed to be improper to permit claims which recite all the means for accomplishing a result except the one shown in the prior art. There is no difficulty in accurately reciting the invention applicant discloses. The Patent Statute requires applicant to distinctly claim his invention. He fails to comply with this requirement by the negative limitation which attempts to exclude one patented device without distinctly claiming his invention.”

See also *In re Schechter and LaForge*, 98 USPQ 144 (C.C.P.A. 1953) affirming the examiner for rejecting a Markush claim that attempted to proviso out the prior art:

“In the light of the prior art of record, the italicised portion of claim 17 is an attempt by appellants to claim their invention by excluding what they did not invent rather than by particularly and distinctly pointing out what they did invent. Further, it is clear that claim 17 is a broad generic claim in which appellants are seeking to establish a monopoly to all such cyclopentenolones, whether known or unknown, excepting the two prior art compounds which are recited in the italicised exclusionary clause of claim 17. In view of this, we think the examiner properly regarded the italicised portion of claim 17 as a negative limitation. We are also of the opinion that this renders the claim indefinite and unpatentable.”

The rejection under 35 USC 103 over WO 2003051877 Zang et al and in view of Bauser et al WO 03014117 and WO03014116 still stands. The declaration does not provide any comparative results. It just states their compounds with the limited R5 and R4 to be H are superior is not convincing. Besides the claims still have R51 to be a H and R4 and R5 together to form a bond which reads on the prior art. See page 11 of the previous office action.

The rejection still stands.

The statutory double patenting rejection over US 10/562149 has been withdrawn as applicants have amended the claims, however it is now an Obvious type double patenting as the the H verses an alkyl is an obvious variant in the absence of unexpected results.

The ODP over the 11/794497 and 11/794494 also still stand as the claims are not allowable and the other applications as still pending.

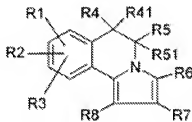
New rejection as the examiner has now included withdrawn claim 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caplus English abstract DN 125:247578, 1996, Algharib Mohammed Sami.



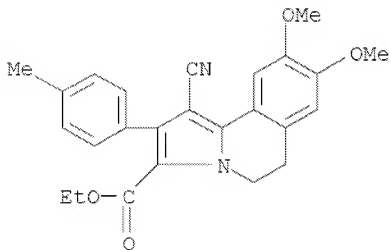
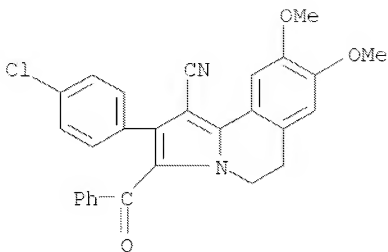
(I)

Applicants claims are drawn to wherein R8 is a
CN, R1-R3 are H or alkoxy, R5 is an alkyl or a bond and R51 is a H or an alkyl. R7 is a phenyl.

Scope and content of the prior art

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The prior art teaches compound s of the formula



FILE 100-20-00 / 08 OCT 1961

Difference between Prior Art and the claims MPEP 2141.02

The difference is in R5 and R51 position .

In applicants amended claims R5 is not H. However R51 can be a H.

Prima Facie Obviousness , Rational and Motivation MPEP 2142-2413

The previous 103 rejection had a similar reasoning . Applicants filed a declaration with a statement saying that their compounds are superior without any side by side comparison. The deficiency between the prior art and applicants compound is a H v methyl , and that modification is prima-facie obvious in the absence of unexpected results.

Conclusion

Claims 1-14 and 17 still stand rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

December 9, 2009.